

REMARKS

Claims 1-21 were pending in this application.

Claims 1, 2, 9, 10, 15, 16, and 21 have been rejected.

Claims 3-8, 11-14, and 17-20 have been objected to.

Claims 2, 10, 16, and 21 have been amended as shown above.

Claim 22 has been added.

Claims 1-22 are now pending in this application.

Reconsideration and full allowance of Claims 1-22 are respectfully requested.

I. ALLOWABLE CLAIMS

The Applicant thanks the Examiner for the indication that Claims 3-8, 11-14, and 17-20 would be allowable if rewritten in independent form to incorporate the elements of their respective base claims and any intervening claims. Because the Applicant believes that the remaining claims in this application are allowable, the Applicant has not rewritten Claims 3-8, 11-14, and 17-20 in independent form.

II. WITHDRAWAL OF RESTRICTION REQUIREMENT

The Applicant thanks the Examiner for the withdrawal of the restriction requirement and full examination of all pending claims.

III. REJECTION UNDER 35 U.S.C. § 112

The Office Action rejects Claims 2, 10, 16, and 21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Office Action rejects Claims 2, 10, 16, and 21 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter regarded as the invention. In particular, the Office Action asserts that the use of the term “bias” in these claims is inconsistent with the “definition” of the term “bias” provided in the specification.

The Applicant respectfully disagrees that the Applicant’s use of the term “bias” is inconsistent with any alleged “definition” of that term. However, the Applicant has amended Claims 2, 10, 16, and 21 to remove unnecessary claim limitations and to resolve a possible antecedent basis issue. The Applicant has also added Claim 22. These amendments also overcome the § 112 rejections.

Accordingly, the Applicant respectfully requests withdrawal of the § 112 rejections and full allowance of Claims 2, 10, 16, and 21.

IV. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1, 9, and 15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,272,401 to Boger et al. (“*Boger*”). This rejection is respectfully traversed.

A prior art reference anticipates a claimed invention under 35 U.S.C. § 102 only if every element of the claimed invention is identically shown in that single reference, arranged as they

are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (*Fed. Cir.* 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (*Fed. Cir.* 1985)).

Boger recites a valve positioner system that facilitates maintenance, calibration, and adjustment requirements of a valve. (*Abstract*). Among other things, the valve positioner system can adjust a BIAS value used by a spool valve 24. (*Col. 9, Lines 23-34*). To avoid possible problems, the valve positioner system may implement intelligent monitoring and adjustment of the BIAS value. (*Col. 9, Lines 35-48*). For example, the BIAS value may not be adjusted if the actual position of the valve 24 is significantly different than the desired position or if the valve 24 is fully opened or fully closed. (*Col. 9, Lines 48-51*). Also, the BIAS value can be adjusted more quickly if the BIAS value is initially adjusted incorrectly and then begins moving towards an average BIAS value. (*Col. 9, Lines 52-58*). Finally, a new BIAS value can be calculated when the valve 24 does not move more than a predefined amount during a predefined time. (*Col. 9, Lines 59-65*).

The cited portions of *Boger* simply describe how a BIAS value can be adjusted. However, *Boger* clearly states that the BIAS value represents the value provided to the spool valve 24 in order to “place the spool valve 24 in the center position,” or the position where an actuator is not filling or exhausting air. (*Col. 9, Lines 26-29*). This has nothing to do with filtering a signal. The cited portions of *Boger* lack any mention that the BIAS value is used to filter a process variable signal, such as a signal representing a flow rate of one or more materials

exiting a tank and flowing through a pipe or a level of one or more materials in the tank. Instead, *Boger* specifically notes that the BIAS value is used to set a valve in its center position.

The Office Action does not explain how setting the BIAS value so that a valve is placed in its center position anticipates using a “cushion filter” operable to “filter [a] process variable signal,” where the cushion filter implements a “cushion in a bias used by the cushion filter” as recited in Claim 1.

For these reasons, the Office Action has not established that *Boger* anticipates the Applicant’s invention as recited in Claim 1. For similar reasons, the Office Action has not established that *Boger* anticipates the Applicant’s invention as recited in Claims 9 and 15.

Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claims 1, 9, and 15.

V. NEW CLAIM

The Applicant has added new Claim 22. The Applicant respectfully submits that no new matter has been added. At a minimum, the Applicant respectfully submits that Claim 22 is patentable for the reasons discussed above. The Applicant respectfully requests entry and full allowance of Claim 22.

VI. CONCLUSION

The Applicant respectfully asserts that all pending claims in this application are in condition for allowance and respectfully requests full allowance of the claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckbutrus.com*.

The Applicant has included the appropriate fee to cover the cost of this AMENDMENT AND RESPONSE. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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